

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re application of: Gratton, Jason et al.

Group Art Unit: 3746

Serial No.: 10/650,166

Examiner: Sung, Gerald Luther

Filed: August 27, 2003

Confirmation No.: 5961

For: ABLATIVE COMPOSITE ASSEMBLIES AND JOINING METHODS THEREOF

Attorney Docket No.: H0004359

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**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

Applicants are in receipt of a Restriction Requirement mailed June 26, 2008, in which three allegedly distinct inventive Groups are identified as follows:

Group I: Claims 1-15, drawn to an ablative composite assembly, classified in class 60, subclass 752;

Group II: Claims 16-22, drawn to an ablative composite valve, classified in class 60, subclass 229; and

Group III: Claims 23-28, drawn to method of manufacturing, classified in class 29, subclass 156.

In addition, the Restriction Requirement mailed June 26, 2008, further identifies the following allegedly distinct Species:

Specie I: wherein the film adhesive comprises a thermosetting film adhesive; and

Specie II: wherein the film adhesive comprises a nitrile phenolic film adhesive.

On page 5, the Office Action acknowledges Applicants' independent Claim 1 as generic to Species I and II.

Through their representatives and attorneys, Applicants hereby elect Group I (Claims 1-15) *with traverse*. Applicants further provisionally elect Specie A (wherein the film adhesive comprises a thermosetting film adhesive) *with traverse*. Applicants identify Claims 1-7, 9-10, 12-21, and 23-28 as encompassing the elected Specie A.

#### Reasons for Traversal of Allegedly Distinct Inventive Groups

Applicants respectfully submit that the asserted restriction requirement is improper, at least with respect to inventive Groups I and II. At least Claim 16 within inventive Group II and at least Claim 1 within inventive Group I are related as AB<sub>sp</sub> / B<sub>sp</sub>, respectively; i.e., Claim 16 recites each and every feature of Claim 1 with the additional feature of “a housing substantially enclosing said first and second ablative composite sub-assembly.” As explained in MPEP § 806.05(c), “[w]here a combination as claimed sets forth the details of the subcombination as separately claimed, there is no evidence that combination AB<sub>sp</sub> is patentable without the details of B<sub>sp</sub>. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.” Accordingly, Applicants respectfully request the withdrawal of the restriction requirement asserted against Groups I and II.

On page 3, the Office Action further states that the “[i]nventions of Groups I and II and Group III are related as process of making and product made.” Emphasis added. However, Applicants’ method Claim 23 (contained within inventive Group III) recites the steps of “providing” every structural feature recited in Applicants’ apparatus Claim 16 (contained within inventive Group II). Thus, the method of Claim 23 cannot be made to make a product materially different from that recited in Claim 16. Nor can the product of Claim 16 be made by a process that is materially different from that recited in Applicants’ Claim 23. Inventive Groups II and III therefore do not meet the test set-forth under MPEP § 806.05(f) and appearing on page 3 of the Office Action. For at least this reason, Applicants respectfully submit that the restriction requirement asserted against Groups II and III should also be withdrawn.

### Reasons for Traversal of Allegedly Distinct Species

On page 4, the Office Action asserts that Species I and II are each independent or distinct “because claims to the different Species recite mutually exclusive characteristics of such Species.” MPEP § 806.04(f) states:

Where two or more Species are claimed, a requirement for restriction to a single Species may be proper if the Species are mutually exclusive. Claims to different Species are mutually exclusive if one claim recites limitations disclosed for a first Species but not a second, while a second claim recites limitations disclosed only for the second Species and not the first. This may also be expressed by say saying that to require restriction between claims limited to Species, the claims must not overlap in scope.

Applicants respectfully submit a nitrile phenolic film adhesive (allegedly distinct Specie B) is a type of thermosetting film adhesive (allegedly distinct Specie A). See, for example, Applicants’ Paragraphs 0020 and 0045 describing thermosetting unsupported nitrile phenolic film adhesives. Therefore, the claims encompassed by Species A and B are not *mutually* exclusive as required to support the asserted restriction requirement. Accordingly, withdrawal of the restriction requirement is respectfully solicited with respect to Species A and B.

Respectfully submitted,

INGRASSIA, FISHER & LORENZ

Dated: July 9, 2008

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